



23 APR 2003

#6

BAKER BOTTS
30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of :
VAN SAARLOOS, Paul, Phillip, et al. :
U.S. Application No. 09/762,824 :
PCT No.: PCT/AU99/00665 :
Int. Filing Date: 16 August 1999 :
Priority Date: 14 August 1998 :
Attorney Dkt. No. A3418-PCT/USA-062635.0133 :
For: SURGICAL VISUAL FEEDBACK AND :
EYE FIXATION METHOD AND :
APPARATUS :

DECISION ON
RENEWED PETITION UNDER
37 CFR 1.137(b) AND
37 CFR 1.47(b)

This decision is issued in response to the "Renewed Petition Under 37 CFR 1.137(b)" filed 12 November 2002. No additional petition fees are required.

BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed 13 May 2002. In that decision, applicant's petition under 37 CFR 1.47(b) was dismissed without prejudice for failure to satisfy all the requirements for a grantable petition. Specifically, the 1.47(b) applicant had not supplied the required evidence to demonstrate its proprietary interest in this application with respect to inventor Paul Van Saarloos. The decision also dismissed applicant's accompanying petition under 37 CFR 1.137(b) on the basis that, until the petition under 37 CFR 1.47(b) was in a grantable form, the "required reply" requirement for a petition under 37 CFR 1.137(b) could not be considered satisfied.

On 15 November 2002, applicant filed the renewed petition considered herein, with accompanying materials.

DISCUSSION

A. Renewed Petition Under 37 CFR 1.47(b)

The previous decision stated that the following was required before the petition could be granted:

the 37 CFR 1.47(b) applicant must provide further evidence to support its claim of proprietary interest with respect to Dr. Van Saarloos. Such evidence should include statements from any persons with first hand knowledge that the invention underlying the present application was made by the inventor during the period of his employment and within the course of the inventor's duties, and a legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in the appropriate jurisdiction award title in the invention to the 37 CFR 1.47(b) applicant.

The renewed petition includes a "Statement Of Facts In Support Of Filing On Behalf Of Nonsigning Inventors (37 CFR 1.47(b))" executed by Ian Jeffrey Constable which provides the required firsthand statement that Dr. Van Saarloos' invention took place during the course of his employment. The renewed petition also includes a legal memorandum which concludes that "it is our view that an Australian Court of competent jurisdiction would by the weight of authority in Australia award title in the Invention to Q-Vis Limited."

The renewed petition therefore satisfies the outstanding requirements for a grantable petition under 37 CFR 1.47(b). The petition is appropriately granted.

B. Petition Under 37 CFR 1.137(b)

The submission of a grantable petition under 37 CFR 1.47(b) satisfies the outstanding "required reply" requirement for a grantable petition under 37 CFR 1.137(b). Applicant has therefore now satisfied all the requirements for a grantable petition.

CONCLUSION

The petition for revival under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.47(b) is **GRANTED**. The application is therefore accepted on behalf of the 37 CFR 1.47(b) applicant without the signatures of nonsigning inventors Paul Van Saarloos and Jon Dishler.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record as set forth in the petition, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

The application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision. The 35 U.S.C. 371 date is 26 December 2001.

A handwritten signature in black ink, appearing to read 'RM Ross'.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459